



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,300	07/10/2003	M. Mintu Bachann	90295-0002	1620

7590 05/05/2005

HOGAN & HARTSON LLP
555 13th Street, N.W.
Washington, DC 20004

EXAMINER

ALPERT, JAMES M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,300

Applicant(s)

BACHANN, M. MINTU

Examiner

James Alpert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 17-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-16, drawn to a method of commercial loan decisioning, classified in class 705, subclass 35.
2. Claims 17-25, and 29, drawn to a method and computer program product of commercial loan decisioning, classified in class 705, subclass 38.
3. Claims 26-28, drawn to a platform (system) for consolidated lending and underwriting, classified in class 705, subclass 38.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1, 2, & 3 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention 1 has separate utility that is unique from the other two, such as "unifying" individual corporate wealth to determine global debt service, and the very specific calculations laid out in Claims 14-16. Invention 2 has separate utility that is unique from the other two, such as receiving a loan request. Invention 3 has separate utility that is unique from the other two, such as a commercial real estate engine for determining lending decisions related to the acquisitions of properties. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above, the search for each invention would necessitate a search for a references teaching the various elements of the invention that are unique to the Invention, but not to the remaining Inventions. This would require multiple searches, and thus the restriction for examination purposes as indicated is proper.

During a telephone conversation with Ajit J. Vaidya, Registration #43214 on 04/21/2005, a provisional election was made with traverse to prosecute the invention of Group 1, Claims 1-16. Applicant in replying to this Office action must make affirmation of this election. Claims 17-29 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected Inventions.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 14 are rejected under 35 U.S.C. 112(1) as failing to comply with the enablement requirement. The claims contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regard to Claim 1, the claim indicates consolidation of information from three possible sources: a borrower, a guarantor, or a property. However, the cash flow recitation does not consider the possibility of receiving information from property, such as rents paid, etc. While this cash flow could be considered as cash flow to the recipient of the income, this is not laid out in the claims, and as such, the application is not enabling.

With regard to Claim 14, the claim indicates that various items are added together in order to determine global debt service. However, the first two items added

Art Unit: 3624

are business name and business purpose. These items are not quantifiable, so this makes the claim impossible to enable.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2,4,14, and 16-17 are rejected under 35 U.S.C. 112(2) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to Claim 1, the claim indicates consolidation of information from three possible sources: a borrower, a guarantor, or a property. However, the cash flow recitation in the second limitation does not consider the possibility of receiving information from property, such as rents paid, etc. Should financial information be chosen from a property, the second step of the claim, calculating cash flow, is no longer available. It is unclear what would occur upon this condition being reached, so the claim is vague and indefinite.

With regard to Claim 2, the claim indicates that a financial institution can regulate its policy and risk in relation to “accepted” regulations. However, what is and is not “accepted” is undefined, and in addition, can vary over time. This renders the claim vague and indefinite.

With regard to Claims 2 and 4, the claims refer to accepted “regulations”. However, government regulations are subject to change, and can vary over time. As

such, it is impossible to be clear on a particular course of action at any given time in relation to the regulations. This renders the claim vague and indefinite.

With regard to Claim 14, the claim indicates that various items are added together in order to determine global debt service. However, the first two items added are business name and business purpose. These items are not quantifiable, so it not unclear how this addition can be performed. This renders the claim vague and indefinite.

With regard to Claim 16-17, the claims indicate various acronyms to describe what appear to be addends to a sum representing global debt service. None of these acronyms are defined, nor is it indicated if there are varying standards for measuring these values. As such, these claims are vague and indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a technological basis, the claims may be interpreted, in an alternative, as involving no more than a manipulation of an abstract idea, and are therefore non-statutory under 35 U.S.C. 101. In contrast, for example, a method claim that includes in the body of the claim a structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669,

Art Unit: 3624

1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential]. Claims 1-16 relate to a method for commercial loan decisioning, however, the preamble and the body of the claims do not indicate that the claims are within the technological arts. To overcome this deficiency, claim language should be considered such that both the preamble and body of the claim indicate a technological basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweeney, U.S. Patent Application Publication #20030065614 in view of Schnall, U.S. Patent Application Publication #20020116323.

With regard to Claim 1, Sweeney teaches a method comprising:

consolidating financial information from at least one of a borrower, a guarantor and a property into a central database; (Page 3, Paras. 37-39)

calculating financial cash flow for at least one of the guarantor and the borrower; and (Page 1, Para. 4)

Sweeney does not specifically disclose:

unifying individual and corporate financial wealth to determine global debt service,

in that Sweeney primarily considers corporate wealth singularly. However, Schnall considers the practicality of maintaining information on secondary party, and collects

Art Unit: 3624

information regarding the secondary source. See (Page 2, Para. 18), which would allows individuals associated with a corporate entity to supplement the corporate information. It would have been obvious at the time applicant's invention was made to combine the teachings of Sweeney relating to collecting and consolidating borrower information with the teachings of Schnall, relating to centralizing the borrower information with information on a second party. The motivation for such a combination is pointed out in Schnall at (Page 1, Para. 7) where it discusses the benefits of maintaining information on all responsible parties, which is mainly the avoidance of default on the loan.

With regard to Claim 2, Sweeney teaches a method further comprising:

determining whether a loans to one borrower threshold is met;
(Page 3, Para. 39)

enabling a financial institution to regulate its credit policy and credit risk in relation to accepted regulations; and (Page 2, Para. 28)

enabling the financial institution to identify demographics.
(Page 1, Para. 15)

With regard to Claim 3, Sweeney teaches a method wherein:

the borrower threshold is a minimum dollar amount.
(Page 3, Para. 39)

With regard to Claim 4, Sweeney teaches a method wherein:

the accepted regulations are at least one of governmental and banking regulations.
(Page 2, Para. 28)

With regard to Claim 5, Sweeney teaches a method wherein:

the demographics include at least one of an industry type and an industry sector.
(Page 2, Para. 28)

With regard to Claim 6, Sweeney teaches a method wherein:

unifying includes determining at least one of the number of borrowers and guarantors;
(Page 3, Paras. 37-39)

obtaining individual financial information;
(Page 5, Table 1, "Personal Credit History")

obtaining individual global debt service information;
(Page 5, Table 1, "Personal Credit History")

Sweeney does not specifically disclose:

generating an individual global debt service report; and generating an individual financial report,

in that Sweeney teaches a "matrix", e.g. report, that considers both personal and corporate indicators. However, Schnall teaches making a debt report on an individual at (Page 3, Para. 32). It would have been obvious at the time applicant's invention was made to combine the teachings of Sweeney relating to collecting and consolidating borrower information with the teachings of Schnall, relating to forming a debt report on the individual. The motivation for such a combination is to present data in a compact, easy-to-use manner, as pointed out in Schnall at (Page 1, Para. 7) where it discusses the benefits of knowing the status of administered loans.

With regard to Claim 7, Sweeney teaches a method wherein unifying further comprises:

obtaining corporate financial information; and
(Page 2, Para. 34 – Page 3, Para 35)

spreading and calculating corporate financial reports.
(Page 3, Para. 42)

With regard to Claim 8, Sweeny teaches a method further comprising:

obtaining a corporate global debt service information;
(Page 2, Para. 34 – Page 3, Para 35)

and generating a corporate global debt service report.
(Page 3, Para. 42)

With regard to Claim 9, Sweeny does not expressly teach a method wherein:

the individual global debt service report includes at least one of asset information and a ratio between income and expenses.

However, Schnall teaches making a debt report including asset information of an individual and a ration in terms of a credit report at (Page 2, Para. 17). It would have been obvious at the time applicant's invention was made to combine the teachings of Sweeney relating to creating a debt service report in the form of a credit analysis with the teachings of Schnall, relating to including asset information and other financial data relating to the applicant for credit. The motivation for such a combination is to present data in a compact, easy-to-use manner, as pointed out in Schnall at (Page 1, Para. 7) where it discusses the benefits of knowing the status of administered loans.

With regard to Claim 10, Sweeny does not expressly teach a method wherein:

the individual financial report includes at least one of a credit report, asset and liability information and tax information.

However, Schnall teaches making a debt report including asset information of an individual and a ration in terms of a credit report at (Page 2, Para. 17). It would have been obvious at the time applicant's invention was made to combine the teachings of Sweeney relating to creating a debt service report in the form of a credit analysis with the teachings of Schnall, relating to including asset information and other financial data

relating to the applicant for credit. The motivation for such a combination is to present data in a compact, easy-to-use manner, as pointed out in Schnall at (Page 1, Para. 7) where it discusses the benefits of knowing the status of administered loans.

With regard to Claim 11, Sweeny teaches the method wherein:

the corporate financial information includes at least one of current assets, liabilities and credit information. (Page 5, Table 1)

With regard to Claim 12, Sweeny teaches the method wherein:

the corporate financial reports include at least one of current asset information, non-current asset information; general liability information, net worth information, income, expenses and adjustments to earnings. (Page 3, Para. 42, Page 5, Table 1)

With regard to Claims 13-16, Sweeny does not specifically detail each of the "formulas" that are claimed for calculating cash flow, individual global debt service, and corporate global debt service. However, these specific formulae are standard accounting techniques and as such, are old and well known in the art. For any of Claims 13-16, it would have been obvious to incorporate these known practices into a method reflecting a Sweeny-Schnall combination that teaches a loan application evaluation and report based upon both individual and corporate cash flow and debt service. The motivation for such an incorporation is stated in Sweeney at (Page 1, Para. 14) where it discusses the importance of standardizing business practices, eg credit-granting decisions, which would occur using established accounting practices.

Conclusion

The following prior art, made of record but not relied upon, is considered pertinent to applicant's disclosure:

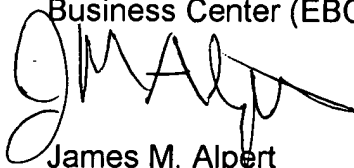
Art Unit: 3624

- a) Phelan et al., U.S. Patent Application Publication #202072927, June 13, 2002, Methods and Apparatus for Automatically Exchanging Credit Information.
- b) Davidson, U.S. Patent #5699527, December 16, 1997, Method and System for Processing Loan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



James M. Alpert
Art Unit 3624

April 27, 2005



ALAIN L. BASHORE
PRIMARY EXAMINER